



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,086	09/12/2003	Jorg Thommes	037003-0305940	6600

7590 09/13/2005

Pillsbury Winthrop LLP
Intellectual Property Group
Suite 200
11682 El Camino Real.
San Diego, CA 92130-2092

EXAMINER

THERKORN, ERNEST G

ART UNIT	PAPER NUMBER
----------	--------------

1723

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,086

Applicant(s)

THOMMES ET AL.

Examiner

Ernest G. Therkorn

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 19, 22, 24-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 9-18, 20, 21, 23 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19, 22, 24-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1723

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is dependent on a non-elected claim. Accordingly, the claim is considered to be indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 19, 24, 25, and 28 are rejected under 35 U.S.C. 102(E) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ma (U.S. Patent No. 6,805,799). The claims are considered to read on Ma (U.S. Patent No. 6,805,799). However, if a difference exists between the claims and Ma (U.S. Patent No. 6,805,799) exists, it would reside in optimizing the steps of Ma (U.S. Patent No.

Art Unit: 1723

6,805,799). It would have been obvious to optimize the steps of Ma (U.S. Patent No. 6,805,799) to enhance separation.

Claims 5, 7-8, 22, 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma (U.S. Patent No. 6,805,799) in view of either Stipanovic (U.S. Patent No. 6,572,767) or Hammen (U.S. Patent No. 5,240,602) and Priegnitz (U.S. Patent No. 5,645,729). At best, the claims differ from Ma (U.S. Patent No. 6,805,799) in reciting use of Protein A. Stipanovic (U.S. Patent No. 6,572,767) (column 2, lines 6-10) discloses that Protein A is a recent purification method for monoclonal and polyclonal antibody production. Hammen (U.S. Patent No. 5,240,602) (column 6, lines 57-59 and column 8, lines 27-28) discloses that the known and anticipated use of Protein A is antibody purification. Priegnitz (U.S. Patent No. 5,645,729) (column 6, line 14) discloses that protein A is a known ligand for use in simulated moving beds. It would have been obvious to use Protein A in Ma (U.S. Patent No. 6,805,799) either because Stipanovic (U.S. Patent No. 6,572,767) (column 2, lines 6-10) discloses that Protein A is a recent purification method for monoclonal and polyclonal antibody production or because Hammen (U.S. Patent No. 5,240,602) (column 6, lines 57-59 and column 8, lines 27-28) discloses that the known and anticipated use of Protein A is antibody purification and Priegnitz (U.S. Patent No. 5,645,729) (column 6, line 14) discloses that protein A is a known ligand for use in simulated moving beds.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ma (U.S. Patent No. 6,805,799) in view of either Stipanovic (U.S. Patent No. 6,572,767) or Hammen (U.S. Patent No. 5,240,602) and Priegnitz (U.S. Patent No. 5,645,729) as

Art Unit: 1723

applied to claim 5 above, and further in view of Garrone (U.S. Patent No. 5,959,085). At best, the claim differs from Ma (U.S. Patent No. 6,805,799) in view of either Stipanovic (U.S. Patent No. 6,572,767) or Hammen (U.S. Patent No. 5,240,602) and Priegnitz (U.S. Patent No. 5,645,729) in reciting use of an acidic buffer. Garrone (U.S. Patent No. 5,959,085) (column 8, lines 55-60) discloses that an acidic buffer is an appropriate buffer for removing an antibody from a column. It would have been obvious to use an acidic buffer in Ma (U.S. Patent No. 6,805,799) in view of either Stipanovic (U.S. Patent No. 6,572,767) or Hammen (U.S. Patent No. 5,240,602) and Priegnitz (U.S. Patent No. 5,645,729) because Garrone (U.S. Patent No. 5,959,085) (column 8, lines 55-60) discloses that an acidic buffer is an appropriate buffer for removing an antibody from a column.

The restriction and elections of species have been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is 571-273-8300.

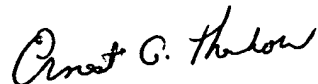
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/661,086

Page 5

Art Unit: 1723

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT
September 9, 2005